

REMARKS

Disposition of Claims:

Claims 1-10 are all the claims pending in the application. Claim 10 has been withdrawn from consideration, as having been cancelled in the Amendment filed on December 23, 2008. Claims 1-9 are rejected. By way of this Amendment, claim 1 has been amended and claim 7 has been canceled.

Claim Rejections Under 35 U.S.C. § 103:

Claims 1-3 and 6-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Plamthottam, et al. (U.S. Patent No. 4,906,421) in view of Tynan (U.S. Patent No. 4,028,302). Further, claims 4-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Plamthottam, et al. in view of Tynan, as applied to claim 1 above, and further in view of Burbank, et al. For the following reasons, Applicant respectfully traverses this rejection.

As amended, claim 1 recites:

A method for the continuous production of a composition comprising rubber (20), a hydrocarbon resin (22), and a solvent (26), which method comprises the following steps:

providing a dual screw extruder;

introducing the rubber and the resin into the dual screw extruder at an initial section thereof;

adding at least a fraction of the solvent (26) at a point of the extruder (10) that is downstream of the initial section;

controlling the temperature of the extruder such that the rubber and the resin are dissolved in the solvent to produce a composition and at the outlet of the extruder (10) the temperature of the composition is less than the boiling point of the solvent (26) such that the composition is an adhesive formulation in which the resin has tackifying properties

Thus, amended claim 1 clarifies beyond any possible doubt that the process of the present invention allows to extrude an adhesive formulation which is dissolved in a solvent.

Plamthottam, et al. - which is now considered the main reference - clearly indicates in the abstract that **“in the extruder, solvent is removed** in one or more solvent removal units and **a solvent-free composition is extruded** as the carrier layer”. Such teachings are irrefutably opposite to the claimed invention, so as it is plainly improper taking Plamthottam, et al. as closest reference in view of its combination with other prior art documents in order to allege the obviousness of the claimed invention. Such combination would indeed distort the basic teaching of Plamthottam, et al. - namely the complete removal of solvent from the extruded composition - making the proposed combination clearly invalid.

The same arguments apply to Burbank, et al. which provides (analogously to Plamthottam, et al.) teachings opposite to the ones of the present invention. On page 4 third paragraph from the bottom, and on page 5, IV and V paragraphs of Burbank, et al., it is indeed emphasized the need of discharging low-end volatiles, i.e. any solvent possibly present in the composition processed in the extruder. Hence, also any argument based on Burbank, et al. is *a priori* moot, because the claimed invention is explicitly directed to extruding an adhesive composition purposively containing a volatile portion, namely a solvent.

The last reference cited - namely Tynan - is fully unconnected with the technical sector of the present invention, namely the production of rubber-based adhesive compositions. It merely discloses a process for preparing concentrated solutions of acrylonitrile polymer in a solvent, which solutions are markedly different from the adhesive formulations of the present invention. In this respect, it has to be emphasized that acrylonitrile may be a component of a rubber (namely butadiene-styrene-acrylonitrile rubber), but is not a rubber per se and even the less in the

context of Tynan, wherein **it is used for the production of acrylic fibers (see e.g. col. 1, line 11) and certainly not of adhesive formulations.**

Hence, a fair evaluation of the content of Tynan necessarily induces to conclude that it is *a priori* not possible to combine in an obvious way its content with the ones of documents belonging to a different technical sector and relative to the production of rubber-based adhesive formulations. In any case - even assuming for the sake of argument that such combination is possible - it is fully unfounded to assume that the result thereof may consist in completely reversing the gist of the processes of Plamthottam, et al. and Burbank, et al., consisting in producing a solvent-free composition.

In sum, it is respectfully submitted that the Examiner has in hindsight picked-up from the various prior art documents just the features necessary for reconstructing the present invention and discarded all the other ones, without any indication in the documents which would have necessarily induced to effect such a capricious choice. Such an approach is plainly improper and not supported by any relevant case-law. In particular, the idea of extruding an adhesive composition dissolved in a solvent is specific to the present invention and fully extraneous to the cited references, Plamthottam, et al. and Burbank, et al. provide indeed solvent-free adhesive compositions, whereas Tynan does not relate at all to adhesive compositions. Hence - contrary to the allegations at paragraph 21 of the outstanding Office Action - the reasoning of the Examiner must necessarily include knowledge gleaned from the Applicant's disclosure and thus is fully unsuitable for legitimately justifying an allegation of obviousness.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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Date: June 25, 2009